

using a plurality of colors including a first color and a second mode for forming the image by using less number of colors including the first color than that of the colors in the first mode... a control section for controlling a current value or a voltage value of the transfer section to control a transfer rate of each of the toner images, wherein the control section controls the transfer section in order that a transfer rate of a toner image of the first color in the second mode is larger than that of a toner image of the first color in the first mode when toner images are transferred onto the intermediate transfer body or the transfer material by the transfer section,

(amended claim 1, ll. 5-15). Independent claim 8 recites yet another combination that includes, *inter alia*,

a transfer section... a selection section for selecting one mode among a plurality of modes including a first mode for forming the image by using a first number of colors and a second mode for forming the image by using a number of colors which is smaller than the first number of colors... a control section for controlling a current value or a voltage value of the transfer section to control a transfer rate of each of the toner images, wherein the control section controls the transfer section in order that a transfer rate of a toner image in the second mode is larger than that of a toner image in the first mode with regard to at least one color used in the second mode when toner images are transferred onto the intermediate transfer body or the transfer material by the transfer section,

(amended claim 8, ll. 5-15). And independent claim 15 recites a further combination that includes, for instance,

a transfer section... a selection section for selecting one mode among a plurality of modes including a first mode for forming the image by using a plurality of colors and a second mode for forming the image by using less number of colors than that of the colors in the first mode... a control section for controlling a current value or a voltage value of the transfer section to control a transfer rate of each of the toner images, wherein the control section controls the transfer section in order that a transfer rate of a toner image in the second mode is larger than that of a toner image in the first mode when toner images are transferred onto the intermediate transfer body or the transfer material by the transfer section,

(amended claim 15, ll. 5-14). At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in independent claims 1, 8 and 15.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Nakagawa et al. and Tukukai, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. See M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Nakagawa et al., the base reference, based on the teachings of Tukukai, the secondary reference, in a manner that could somehow result in the claimed invention. See *id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the device of Nakagawa et al. in a manner that could somehow result in the claimed invention. See *id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. See *id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from

accountability.” *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Nakagawa et al., taken alone or in combination with Tukukai, can either anticipate or render obvious each and every one of the limitations present in independent claims 1, 8 and 15, as required by the MPEP and Federal Circuit jurisprudence.

As discussed in the Amendment dated January 5, 2006, Nakagawa et al. discusses improving printing efficiency in cases of forming images of documents which contain monochrome pages without color images and multi-color pages with color images. (For example, see Paragraph [0009]). In addition, Nakagawa et al. discloses controlling the timing of mode changes from a multi-color image forming mode to monochrome image-forming modes. The control apparatus is utilized to control switching of conveying speed during multi-color image forming and conveying speed during monochrome image forming.

The Examiner asserts that Nakagawa et al. discloses a control section for controlling the transfer section, for instance, in FIGS. 8B and 9B. Nakagawa et al. shows a structure to control the speed of transfer and a conveyance belt. However, Nakagawa et al. fails to teach structure for controlling the transfer rate, such as by controlling a current value or a voltage value of the transfer section to control a transfer rate of each of the toner images, as recited in claims 1, 8 and 15. The claimed structure

for controlling the transfer rate makes it possible ,*inter alia*, to control a transfer rate of a toner image of the first color in the second mode (monochrome mode) to be larger than that of a toner image of the first color in the first mode (full color mode).

Moreover, the Examiner admits that Nakagawa et al. fails to provide any disclosure of a control section for controlling a current value or a voltage value of the transfer section to control a transfer rate of each of the toner images, as recited in greater detail in independent claims 1, 8 and 15. The Examiner attempts to remedy the deficiencies of Nakagawa et al. by turning to Tukukai. Tukukai discusses adjusting a current value of a transfer means to address a transfer position of a first color and a last color in proximity to one another when an image forming apparatus is downsized. However, Tukukai fails to disclose or suggest a control section as recited in claims 1, 8, and 15.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Nakagawa et al. nor Tukukai, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claims 1, 8 and 15. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-3, 5-7, 37 and 40 depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 1.

Claims 9-10, 12-14, 38 and 41 depend from independent claim 8 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 8.

Claims 16-17, 19-21, 39 and 42 depend from independent claim 15 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 15.

In addition, each of these dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings.

Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 408-4328.

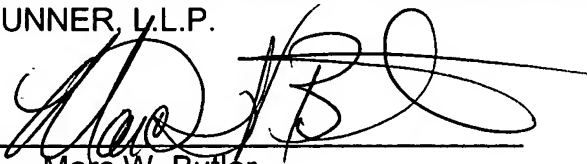
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT
& DUNNER, L.L.P.

Dated: May 5, 2006

By:

A handwritten signature in black ink, appearing to read 'Marc W. Butler', is written over a horizontal line.

Marc W. Butler
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